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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,873	12/30/2004	Walter Stieglbauer	STIEGLBAUER ET AL - I PCT	7849
25889	7590	11/01/2007	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			KERNS, KEVIN P	
			ART UNIT	PAPER NUMBER
			1793	
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			11/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/519,873	Applicant(s) STIEGLBAUER ET AL.	
	Examiner Kevin P. Kerns	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7 and 9 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 9 is objected to because of the following informalities: in the 2nd line, the claim dependency should be from claim 1, not from (cancelled) claim 8. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-4, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okita et al. (US 5,552,573).

Okita et al. disclose a resistance welding process and apparatus for welding of aluminum and aluminum alloy workpieces (e.g. metal sheets), in which the apparatus includes an insert material 9 provided over the electrode 1 and between the electrode 1 and the workpieces (11,12) as holding means for the insert material 9 (strip), such that the insert material 9 has a sheet-like core material 9a made of iron, steel, copper, or copper alloy (having melting temperatures above 1000°C), and congruently arranged coated strip layers (9b,9c) made of Ni, Ni alloy, Ti, Ti alloy, Nb, Nb alloy, Mo, Mo alloy, W, W alloy, Cr, Cr alloy, Co, and Co alloy (having melting temperatures above 1000°C) that face the electrode 1 and workpieces (11,12), such that the superimposed strips (9a,9b,9c) would be exclusively positively connected via metallic (diffusion) bonding (e.g. plating, clad welding etc.) between the two metals, while the strips are able to be displaceably held via holding means at different speeds relative to each other via reels (22,23,24,25) – (i.e. means for driving and holding the strip -- see Figure 5; and column 10, lines 43-51), with little or no adhesion of the strips to the electrode and workpieces during resistance welding (abstract; column 3, lines 24-58; column 4, lines 32-48; column 7, lines 1-26; 1st paragraphs of Examples 1-13; and Figures 1, 2, 5, and 6).

Although Okita et al. do not specifically disclose that the connections of the metal strips are by rabbeting or stamping, one of ordinary skill in the art would have recognized that these types of connections are similar in establishing a similar result as the clad welding process disclosed by Okita et al., as all three of these types of connections result in establishing a “bond” or “joining interface” between the two metal strips, thus suggesting the limitation “exclusively positively connected” of independent claim 1. Furthermore,

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one of ordinary skill in the art would have found it to have been "obvious to try" these various types of connections, since the applicants are choosing from a finite number of identified predictable solutions with a reasonable expectation of success, in order to establish the predictable result of obtaining a joining interface between the metal strips.
KSR Int'l Co. v. Teleflex Inc., 82 USPQ.2d 1385 (S.Ct. 2007).

Response to Arguments

5. The examiner acknowledges the applicants' amendment provided with the request for continued examination received by the USPTO on August 30, 2007. The applicants' amendment overcomes prior 35 USC 112, 2nd paragraph rejections. However, a new objection to claim 9 is raised in above section 1. The 35 USC 102(b) rejections in view of Okita et al. are overcome by the applicants' amendment. However, the Okita et al. reference is still applied in the 35 USC 103(a) rejections of above section 4 (with addition of newly underlined portions to establish obviousness). The applicants have cancelled claim 8. Claims 1-4, 7, and 9 are currently under consideration in the application.

6. Applicants' arguments with respect to claims 1-4, 7, and 9 have been considered but are moot in view of the new ground(s) of rejection.

With regard to the applicants' remarks/arguments on pages 5-7 of the amendment, the applicants are referred to the newly underlined portions of the 35 USC

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103(a) rejections which show additions of disclosed and/or suggested claimed features (particularly, as taken in view of amended independent claim 1) in above section 4.

With regard to the remarks/arguments on pages 5-7, the applicants' major argument continues to be that the metal strips of Okita et al. are not "exclusively positively connected" by either rabbeting or stamping. The examiner respectfully disagrees that Okita et al. would allegedly not find these features to be obvious, as set forth in the rationale of the underlined portions of above section 4. As a result, claims 1-4, 7, and 9 remain rejected.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kevin P. Kerns whose telephone number is (571) 272-1178. The examiner can normally be reached on Monday-Friday from 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jonathan Johnson can be reached on (571) 272-1177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kevin P. Kerns *Kevin Kerns 10/30/07*
Primary Examiner
Art Unit 1793

KPK

kpk

October 30, 2007